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MARTINE EXAMINER

18N2/0907

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NEW YORK, NY 10036

ART UNIT PAPER NUMBER

1805

23

DATE MAILED: 09/07/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 07/18/94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input checked="" type="checkbox"/> <u>Suggestion for Deposit of</u>
<u>Biological Material</u> |

Part II SUMMARY OF ACTION

1. ☒ Claims 10-15 and 30-59 are pending in the application.
Of the above, claims 53, 54, 58, and 59 are withdrawn from consideration.
2. ☒ Claims 1-9 and 16-29 have been cancelled.
3. ☒ Claims 11-14, 30-35, 38-41, and 44-47 are allowed.
4. ☒ Claims 10, 15, 36, 37, 42, 43, 48-52, 55, and 57 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

The disclosure is objected to because of the following informalities.

- (a) In claim 32, line 9 of the sequence, "Ais" should be changed to "His".
- (b) Claim 33 should end with a period.

Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure. It is not evident that each of the plasmids and microorganisms mentioned in claims 10, 15, 36, 37, 42, 43, and 48 is permanently available to the public. A "Suggestion for the Deposit of Biological Material" is attached to this Office action. The "Notice Re Deposit of Microorganism" filed August 29, 1983 is insufficient to establish permanent availability because the contract with the ATCC is for 30 years from the date of deposit (i.e. September 16, 1980), which period does not include the entire enforceable life of the patent. Additionally, the availability of plasmid pSC1 has not been established.

Claims 10, 15, 36, 37, 42, 43, and 48 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 11-14 and 30-48 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as the invention.

The claims are vague, indefinite, and incomplete.

- (a) It is not known what is meant by "pSC1" (claims 36, 37, 42, and 43).
- (b) The meaning of "codes at least for" (claims 30, 32, 44, and 45) is vague and indefinite because it is not known whether the DNA may encode another amino acid sequence.
- (c) The recitation of "comprises at least" (claims 31 and 33) is vague and indefinite because the meaning of the term "at least" is not understood in conjunction with the open term "comprising".
- (d) The recitation of "codes for at least" (claims 38 and 39) is vague and indefinite (see (b) above).

Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 305-3014.

Any inquiry concerning this communication should be directed to J. Martinell at telephone number (703) 308-0296.


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SENIOR LEVEL EXAMINER
GROUP 1800